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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,710	10/09/2001	Peggy-Jean P. Flanigan	55526US003	7863
32692 7590 06/29/2007 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER CHEVALIER, ALICIA ANN	
			ART UNIT 1772	PAPER NUMBER
			NOTIFICATION DATE 06/29/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

09/974,710

**Applicant(s)**

FLANIGAN ET AL.

**Examiner**

Alicia Chevalier

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-17,19-22,26-53 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) 36-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-17,19-22,26-35, 53 and 55-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **RESPONSE TO AMENDMENT**

1. Claims 1, 3-8, 10-17, 19-22, 26-53 and 55-60 are pending in the application, claims 36-52 are withdrawn from consideration. Claims 2, 9, 18, 23-25, 54, 61 and 62 have been cancelled.
2. Amendments to the claims, filed on April 9, 2007, have been entered in the above-identified application.

### ***WITHDRAWN REJECTIONS***

7. The 35 USC 112 rejections, made of record in the response filed January 10, 2007, pages 3-4, paragraph #7 have been withdrawn due to Applicant's amendment in the response filed April 9, 2007

### ***REJECTIONS***

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Claim Rejections - 35 USC § 102***

4. Claims 1, 3, 4, 6-8, 11-13, 15, 17, 19-22, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hauser et al. (U.S. Patent No. 3,179,552).

Hauser discloses an article (*tape, title*) comprising at least one adhesive layer (*figure 2*) with a first major surface and a second major surface wherein at least one of the first and second major surface is a structured surface and a backing laminated (*film backing, figure 2*) to the

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structured surface of the adhesive layer wherein the exposed surface of the backing is unstructured (*figure 2*), wherein the article comprises discrete reservoirs or channels (*figure 2*) between the structured surface of the adhesive layer and the backing and wherein the article has a non-structured exposed adhesive surface that can be adhered to a target substrate (*figure 2*). The at east one adhesive comprises a tacky rubber-resin type pressure sensitive adhesive (*col. 1, lines 53-54*). The article further comprises at least one non-adhesive layer in contact with on of the first and second major surfaces (*figure 2*) and comprises a non-structured exposed surface (*figure 2*). The article comprises a plurality of channels (*figure 2*). The reservoirs/channels contain at least one non-deliverable solid substance (*yarns, col. 1, lines 51-52*). The backing is deemed to be a laminate (*figure 2*).

Hauser discloses a tape comprising at least one pressure sensitive adhesive layer comprising a first major surface and a second major surface, wherein the first major surface is a structured surface and the second major surface is a non-structured surface and a non-adhesive flexible backing laminated to the first major surface, wherein the tape comprises discrete reservoirs/channels between the structured surface of the adhesive layer and the backing (*figure 2 and col. 1, lines 42-46*). The tape is deemed to have a peel strength of at least 21-42 oz/0.5 inch for a thickness of 0.0003 to 0.007 inches, since Hauser also discloses a pressure sensitive adhesive layer and a backing layer.

5. Claims 1, 3, 4-8, 11-17, 19-22 and 26-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Hidaka et al. (U.S. Patent No. 4,801,458).

Hidaka discloses an article comprising at least one adhesive layer (*figure*) with a first major surface and a second major surface wherein as least one of the first and second major

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surface is a structured surface and a backing laminated (*figure, reference #1 and #2*) to the structured surface of the adhesive layer wherein the exposed surface of the backing is unstructured (*after release sheet 5 is removed, figure and col. 3, lines 1-2*), wherein the article comprises discrete reservoirs or channels (*figure and col. 2, lines 67 through col. 3, line 2*) between the structured surface of the adhesive layer and the backing and wherein the article has a non-structured exposed adhesive surface that can be adhered to a target substrate (*figure*). The at least one adhesive comprises a rubber-resin type pressure sensitive adhesive etc. (*col. 6, line 67 through col. 7, line 22*). The thickness of the article is about 2-500 micrometers (*col. 7, lines 27-29 and col. 9, lines 25-27*). The article further comprises at least one non-adhesive layer in contact with one of the first and second major surfaces (*figure*) and comprises a non-structured exposed surface (*figure*). The reservoirs/channels contain at least one non-deliverable and deliverable substance such as drugs (*hollow fibers containing medicine, col. 1, lines 11-13 and col. 4 line 28 through col. 6, line 43*). The backing is deemed to be a laminate (*figure*). The second major surface further comprises a backing layer (*release sheet, figure and col. 3, lines 1-2*).

Hidaka discloses a tape comprising at least one pressure sensitive adhesive layer comprising a first major surface and a second major surface, wherein the first major surface is a structured surface and the second major surface is a non-structured surface and a non-adhesive flexible backing laminated to the first major surface, wherein the tape comprises discrete reservoirs/channels between the structured surface of the adhesive layer and the backing (*figure and col. 6, line 67 through col. 7, line 22*). The tape is deemed to have a peel strength of at least

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21-42 oz/0.5 inch for a thickness of 0.0003 to 0.007 inches, since Hidaka also discloses a pressure sensitive adhesive layer and a backing layer.

6. Claims 53 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton et al. (U.S. Patent No. 5,662,758).

Hamilton discloses an article comprising at least one first layer with a first major surface and a second major surface, wherein at least one of the first and second major surface is a structured surface, and a cap layer laminated to a structure surface of the first layer, wherein the cap layer comprises an adhesive and wherein the cap layer is non-structured on both surfaces and wherein the artic has a non-structured exposed surface that can be adhered to a target substrate (*figure 10 and figure 4*). The first layer comprises a polymeric film (*col. 6, line 1*).

#### ***Claim Rejections - 35 USC § 103***

7. Claims 10 and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka et al. (U.S. Patent No. 4,801,458).

Hidaka is relied upon as described above.

Hidaka fails to disclose that the reservoir has a void volume of less than 100 microliters.

The exact void volume of the reservoir is deemed to be a result effective variable with regard to the amount of medication needed. It would require routine experimentation to determine the optimum value of a result effective variable, such as void volume, in the absence of a showing of criticality in the claimed volume. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to use a small void volume in order not to over medicate a patient.

***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments in the response filed April 9, 2007 regarding the 35 USC 112 rejections of record have been considered but are moot since the rejections have been withdrawn.

9. Applicant's arguments in the response filed April 9, 2007 regarding the 35 USC 102 rejection over Hauser of record have been carefully considered but are deemed unpersuasive.

Applicant quickly summarizes Hauser and then argues, therefore Hauser does not teach an article with an adhesive layer with a structured surface and a backing laminated to the structured surface wherein the article comprises discrete reservoirs between the structured surface of the adhesive layer and the backing. Applicant further argues that the rejection seems to imply that reference number 7 in figure 2 is a discrete reservoir.

First, the examiner was not implying that reference 7 was the discrete reservoir. The area between the structures created by reference number 7 is considered to be the reservoirs. Second, Applicant has not specifically pointed out why Hauser does not disclose an article with an adhesive layer with a structured surface and a backing laminated to the structured surface wherein the article comprises discrete reservoirs between the structured surface of the adhesive layer and the backing. Therefore, the examiner maintains Hauser reads on the claims.

10. Applicant's arguments in the response filed April 9, 2007 regarding the 35 USC 102 rejection over Hidaka of record have been carefully considered but are deemed unpersuasive.

Applicant argues that even if numbers 3 and 4 could be considered a structured surface, the backing is not laminated to the structured surfaces of the adhesive and therefore does not form discrete reservoirs between the structures surface and the adhesive layer and backing.

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The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Applicant has not shown how the structure of Hidaka differs from the instant claimed invention. Furthermore, the figure clearly shows discrete reservoirs between element #3.

11. Applicant's arguments in the response filed April 9, 2007 regarding the 35 USC 102 rejection over Hamilton of record have been carefully considered but are deemed unpersuasive.

Applicant argues there is no teaching in Hamilton of a cap layer.

Claim 53 recites that "the cap layer comprises an adhesive" and "is non-structured on both surface." Hamilton clearly discloses an adhesive layer that has not peaks or valleys, i.e. it's flat on both sides, which is what is considered Applicant's non-structured side.

12. Applicant's arguments in the response filed April 9, 2007 regarding the 35 USC 103 rejection over Hidaka of record have been carefully considered but are deemed unpersuasive.

Applicant's arguments regarding the Hidaka reference have already been addressed above.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

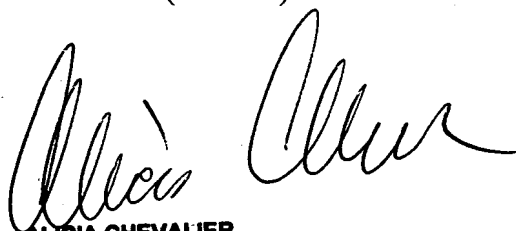
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

6/25/07

  
**ALICIA CHEVALIER**  
**PRIMARY EXAMINER**